

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

A Notice of Appeal is filed simultaneously herewith. This application was allowed in April 2004 and the issue fee was paid in July 2004. It was pulled back from issue and a new ground for rejection was presented in an action dated May 18, 2005. The Applicant responded to the new rejection and the Examiner withdrew the rejection and issued a second new ground for rejection in an action dated October 21, 2005. The Applicant responded to the second new ground for rejection and the Examiner withdrew it and entered a third new ground for rejection on April 21, 2006. During a telephone conversation with the Examiner on August 15, 2006, the Examiner indicated that this application had a “red flag” and that should the Applicant overcome the third new ground for rejection, he would issue a fourth new ground for rejection. During a telephone conversation with SPE Andrew Caldwell on August 15, 2006, Examiner Caldwell suggested that the Applicant file a request for a pre-appeal brief conference in order to resolve what seems to be endless unproductive prosecution of this application.

This invention concerns an electronic mail client system which is composed of two or more components: a mail handling component for sending and receiving email messages and one or more authoring/reading components for creating and viewing email messages. The authoring/reading components are capable of authoring messages in different modes. According to one embodiment, the modes determine how the message will be displayed to the recipient. According to a second embodiment, the modes determine what tools the recipient can use to respond to the message. According to a third embodiment, the modes determine whether the recipient will be able to view all of the message or only parts of the message. According to a fourth embodiment, the modes

determine how the message appears to be organized when viewed by the recipient. The modes are preferably encoded into the message as a MIME-type. The invention benefits correspondents who need to exchange the same information but organized in different ways or where some recipients of an email message do not need all of the information contained in it but others do. Examples of such correspondents include customer and vendor, teacher and student, auctioneer and bidder, and doctor and patient.

The current rejection of the claims is clearly incorrect for the following reasons. First, although the application contains claims 1-27, only claims 4, 8-13, and 24 are specifically addressed by the Office Action. The other claims are rejected merely by stating that they contain “similar limitations” and are “rejected for the same rationale” as claims 8-13. Clearly there are significant differences in at least some of the claims which have not been addressed as compared to claims 8-13 and the rejection of those claims is clearly improper. For example, compare claims 1, 14, 19, and 22 with claims 8-13.

Second, all of the claims except claims 4 and 24 are rejected as anticipated by Kamiya which discloses an electronic information system for automatically distributing messages and documents which is designed to replace email systems. In Kamiya, information is distributed via collectors, rosters and links. Collectors are analogous to email in-boxes. Contents of collectors are shared by linking them to each other or to rosters and are viewed as web pages. However, Kamiya does not teach or suggest several of the limitations of the claims which are being rejected.

For example, claim 8 requires first and second email clients having first and second authoring/reading components where the first component creates messages in a first mode, the second component reads messages in a second mode, and each mode

causes messages to be displayed in a different manner. The Examiner refers to “write authorization” as the first mode and “read authorization” as the second mode and states that each mode causes messages to be displayed in a different manner, “displayed with iconic representation of their type and attributes, col 24 lines 13-25, Fig 17”. Clearly, this rejection is riddled with non-sequiturs. Read and write authorization have nothing to do with the claimed modes of authoring and reading. In addition, the list of messages in Fig. 17 is not created by the first authoring component and it is not a message; it is a list of messages.

As to the rejection of claim 10 (anticipated by Kamiya), the Examiner has clearly misunderstood something because claim 10 specifies that the mode of displaying a message is encoded in the message by the first authoring/reading component and determined by the second authoring/reading component when the message is read. In rejecting this claim, the Examiner merely refers to “proxy server, Fig 13(b)”.

Claim 11 specifies that depending on the mode of a message, different tools are allowed to be used to respond to it. The Examiner refers to Figs. 14a and 17 of Kamiya as anticipating this claim. Clearly Figs. 14a and 17 of Kamiya do not illustrate any tools for responding to an email message.

Claim 12 specifies that the different modes of an email message determine whether the viewer can see all of the message or part of the message. In rejecting this claim, the Examiner merely refers to Fig 14(a) of Kamiya and states “displayed in subwindows”. Fig. 14(a) is a web page. See col. 6, line 25 of Kamiya.

Claim 13 specifies that the different modes of an email message will dictate how the information in the messages appears to be organized when viewed. Here the

Examiner refers to “authorize attributes read-write, col 4 lines 26-36”. This clearly has nothing to do with how a message appears to be organized.

The rejection of claims 4 and 24 is a §103 rejection combining Kamiya and Shaffer. These claims specify that the mode of the email message is encoded as a MIME-type. Shaffer talks about using MIME to encode an attachment to an email message. The Examiner’s stated incentive to combine Shaffer with Kamiya is to “provide an efficient and reliable exchange of attached files by using the email service with MIME encoding via Internet.” However, claims 4 and 24 have nothing to do with attached files.

For the foregoing reasons, it is respectfully submitted that this application is in order for allowance. Please remember that this application was examined five times, allowed after the second examination and then new searches and new art cited three times thereafter. Four separate searches were performed in attempts to reject these claims. All of the prior rejections were withdrawn after argument by the Applicant. It is believed that the current incomplete rejection should fail on the merits as well as on procedural grounds and that reopening prosecution to conduct a fifth search is a waste of the resources of both the Applicant and the Patent Office.

Respectfully submitted,

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